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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,266	06/20/2003	Fumitoshi Asai	03337C/HG	7488

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EXAMINER	
KWON, BRIAN YONG S	
ART UNIT	**PAPER NUMBER**
1614	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/600,266	ASAI ET AL.	
	Examiner	Art Unit	
	Brian S. Kwon	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/06/2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *6-14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 15-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. Acknowledgement is made of applicants' filing of the instant application as a Request for Continued Examination (RCE) under 37 CFR 1.1114. Claims 1-5 and 15-19 are currently pending for prosecution on the merits.

New Matter

2. The amendment filed December 09, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "there is no thromboxane A2 receptor antagonist".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims in this application introduce a negative limitation as discussed in preceding comments, namely "there is no thromboxane A2 receptor antagonist". The examiner determines that when all evidences in the original disclosure are considered and carefully reviewed, the newly amended claims fail to find support in the original specification.

The specification only positively states about the boundaries of the claim. There is no express statement about the negative limitation that can be found in the specification. Thus, the exclusion of said elements implies the inclusion of all other elements not expressly excluded, clearly illustrating that such negative limitations do, in fact, introduce new matter. The negative limitation recited in the present claims, which did not appear in the specification filed, introduces new concepts and violate the description requirement of the first paragraph of 35 USC 112.

Applicant could obviate this rejection by canceling "an wherein there is no thromboxane A2 receptor antagonist" and amending the claims, for example claim 1 "A pharmaceutical composition consisting essentially of...in a ratio by weight of 1:500 to 500:1".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogletree (US 6509348) in view of Bernat et al. (US 5989578).

Ogletree teaches a pharmaceutical composition comprising ADP receptor blocking antiplatelet drug (i.e., CS-747 which is 2-acetoxy-5-(alpha-cyclopropylcarbonyl-2-fluorobenzyl)-4-5,6,7-tetrahydrothieno[3,2-c]pyridine, clopidogrel and ticlopidine) or pharmaceutically acceptable salts thereof in combination with thromboxane A2 receptor antagonist and aspirin, wherein the ratio of said ADP receptor blocking antiplatelet drug and aspirin is within the range from about 50:1 to about 0.51, preferably from about 25:1 to about 1:1 (see column 4, lines 18-

30 and 38-42; column 31, lines 32-37). Ogletree discloses CS-747 as the functional equivalent to other known ADP receptor blocking antiplatelet drug such as clopidogrel and ticlopidine.

Bernat teaches a pharmaceutical composition comprising ADP receptor blocking antiplatelet drug (i.e., clopidogrel or ticlopidogrel) in combination with aspirin.

The teaching of Ogletree differs from the claimed invention in the preparation of said composition in absence of thromboxane A2 receptor antagonist. To incorporate teaching of Ogletree, would have been obvious in view of Bernat who teaches the routine knowledge in preparing combination of ADP receptor blocking antiplatelet drug and aspirin in absence of thromboxane A2 receptor antagonist

Above references in combination make clear that making combinations of three components, (a) ADP-receptor blocking antiplatelet drug, (b) tromboxane A2 receptor antagonis and (c) aspirin or combination of two components, (a) ADP-receptor blocking antiplatelet drug and (c) aspirin is well known in the art. Thus, one would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

5. Claims 4-5 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogletree (US 6509348) in view of Bernat et al. (US 5989578), and further in view of Koike et al. (US 5288726). See rejection above.

The modified teaching of Ogletree mentioned above (Ogletree and Bernat et al.) includes all that is recited in claims 4-5 and 18-19 except the use of the specific salt form, namely hydrochloride or maleate.

However, it would have been obvious in view of Koike who teaches compounds represented by formula (I) including 2-acetoxy-5-(alpha-cyclopropylcarbonyl-2-fluorobenzyl)-4-5,6,7-tetrahydrothieno[3,2-c]pyridine, wherein said compounds are prepared in pharmaceutically salts thereof including maleate and hydrochloride (abstract; column 13, lines 43-63; column 22, line 19 and Example 23).

One having ordinary skilled in the art would have been motivated to select the claimed compounds in maleate or hydrochloride salt with reasonable expectation of success that preparation of said composition in maleate and hydrochloride salt form would not significantly alter the analogous properties of compound of the reference due to close structural similarity of the compounds.

Response to Arguments

6. Applicant's arguments and Declaration filed May 05, 2006 have been fully considered but they are not persuasive.

Applicant's argument in the response takes the position that the present application, as originally filed, clearly supports the claims and that applicant was in possession of the invention when the application was filed. Applicant asserts that the new claims do not represent a different invention than was originally disclosed and claimed-they just claim less of the original invention. Especially in view of the nature of pharmaceutical compositions and the strong controls over what they may contain, a person skilled in the art does not expect pharmaceutical formulations to contain unnamed ingredients and especially unnamed ingredients that affect the essential properties of the composition.

This argument is not found persuasive. As discussed above (similarly in the page 3 of the O.A. mailed 03/06/2006) the specification only positively states about the boundaries of the claim. There is no express statement about the negative limitation that can be found in the specification. Thus, the exclusion of said elements implies the inclusion of all other elements not expressly excluded, clearly illustrating that such negative limitations do, in fact, introduce new matter. The negative limitation recited in the present claims, which did not appear in the specification filed, introduces new concepts and violate the description requirement of the first paragraph of 35 USC 112.

Applicant's argument in the response takes the position that the Examiner ignores the Declarations by Atsuhiro SUGIDACH which provides evidence of a synergistic effect when compound A and aspirin are used together as compared to when clopidogrel or ticlopidogrel and aspirin are used together. Applicant asserts that the present invention is not taught or suggested in the prior art since the synergistic effect is unexpected from the combination rejection.

Applicant's Declaration has been fully considered but they are not persuasive. The submitted data showing Ex vivo effects of Compound A and clopidogrel in combination with or without aspirin on collagen-induced platelet aggregation is insufficient to overcome the instant rejection. Applicant's submitted data is not based on the unexpected results over the combination of Compound A+thromboxane A2 inhibitor+aspirin. Thus, in absence of data showing the exclusion of thromboxane A2 inhibitor would provide the superior unexpected results over the composition of Ogletree, the examiner maintains that the instant invention is obvious over the cited references in combination.

Conclusion

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see http://pair-direct.uspto.gov Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Brian Kwon
Patent Examiner
AU 1614